

**REMARKS**

Claims 9, 12 and 13 are pending in this application. By this Amendment, claims 9, 12 and 13 are amended. The amendments introduce no new matter. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

The Office Action rejects claims 12 and 13 under 35 U.S.C. §103(a) over WO 00/56393 (hereinafter "WO '393") in view of U.S. Patent No. 6,847,847 to Nisch et al. (hereinafter "Nisch"); and rejects claim 9 under 35 U.S.C. §103(a) over WO '393 in view of Nisch and further in view of U.S. Patent No. 2,760,483 to Tassicker. These rejections are respectfully traversed.

Without conceding the interpretation, or combinations, of the applied references, claims 9, 12 and 13 are voluntarily amended to clarify relevant features. The applied references do not teach, nor can they reasonably be considered to have suggested, the features of claims 9, 12 and 13 for at least the reasons discussed below.

WO '393 is directed to a technique for electrical 14 stimulating a retina by placing an electrode array including a plurality of stimulation electrodes on or under the retina in direct contact relation. This reference neither teaches, nor can it reasonably be considered to have suggested, a feature of the electrode arrays inserted in a sclerotic flap formed by partially incising a sclera of a patient's eye to place stimulation electrodes outside a choroid (on a sclera side) to pass an electric current between the stimulation electrodes and a reference electrode (an indifferent electrode).

Nisch discloses a retina implant including a chip 36 to be placed in sub-retinal contact with a retina (between a choroid and the retina) through a sclera incision 20 to electrically stimulate the retina. Nisch teaches that the chip is placed under the retina, however, they do

not present a configuration that the stimulation electrodes are placed outside the choroid (on a sclera side).

According to the pending claims, the stimulation electrodes are placed outside the choroid (on a sclera side). Further, electrical stimulation pulse signals having current intensity enough to pass through the choroid and the sclera are output from the stimulation electrodes to the indifferent electrode through an electrical circuit, so that the retina can be electrically stimulated appropriately even though the choroid is interposed between the electrode. The combination of WO '393 and Nisch does not teach, nor can it reasonably be considered to have suggested, such features.

The Office Action relies on Tassicker as disclosing that the electrode arrays placed between the choroid and the sclera. The Office Action concludes that it would have been obvious to one of ordinary skill in the art to choose such a placement so as to make the operation easier whereby a detached retina does not result. However, modifying either of Nisch or WO '393 would not have been obvious to one of ordinary skill in the art for at least the reasons discussed below.

Tassicker discloses an apparatus, with no photographing device outside a body, that is arranged to directly receive light entering a patient's eye by a photo-active retinal stimulator that, in response to the light reception, outputs a stimulation signal to stimulate a retina. As argued previously, an apparatus of this type is significantly different in its method of operation for stimulating a retina from an apparatus having no light-receiver in the patient's eye, as in the present subject matter. Thus, it is technically unreasonable to combine such different types of apparatuses. In other words, it would not have been ordinary to one of ordinary skill in the art to combine the references in the manner suggested. Significantly, the considerations and function of a photo-receptor, as in Tassicker, do not correspond to electrodes driven by electrical stimulation pulse signals, as in the pending claims, in sufficient manner to have

motivated one of ordinary skill in the art to arrive at the present subject matter through any combination of WO '393, Nisch and Tassicker.

Further, the alleged motivation to combine presented in the abbreviated conclusory statement is not enough to prove that there is a teaching, suggesting or motivation in the prior art to combine the references in the manner suggested by the Office Action. The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, Appeal No. 04-1616, March 22, 2006 (Fed. Cir.) (quoting *In re Lee*" 277 F.3d 1338,1343 46 (Fed. Cir. 2002)). This standard is not met here as no articulated reasoning with some rational underpinning is provided.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the result in combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See, e.g., In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). It is respectfully submitted that the rejections of any of the pending independent claim is improper in view of at least MPEP §2143.01, and the above cited judicial precedent, because the Office Action lacks the required specific evidence of a teaching, suggest or motivation in the prior art for one of ordinary skill to have combined the references in the manner suggested in order to render the subject matter of the pending claims obvious over any permissible combination of those references.

For at least the above reasons, no permissible combination of the applied references can reasonably be considered to have suggested, the combinations of features positively

recited in independent claims 9, 12 and 13. Accordingly, reconsideration and withdrawal of the rejection of claims 9, 12 and 13 are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 9, 12 and 13 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

Petition for Extension of Time

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